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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,188	01/29/2002	Philip G. Costello	BG-13201	3935

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EXAMINER	
KRAMER, DEVON C	
ART UNIT	PAPER NUMBER
3683	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,188

Applicant(s)

COSTELLO ET AL.

Examiner

Devon C Kramer

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 3-4 8 10-12 14-26 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,9,13,27-33 and 35-40 is/are rejected.
- 7) ☒ Claim(s) 41-44 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2) Claims 1-2, 5-7, 9, 13 and 27-33 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuspert et al (5810339) in view of Besonen et al (5307753).

In reference to claims 1, 27 and 35-40, Kuspert et al teaches the use of a counterbalance comprising a protective housing (22, 23) having a first end / tube (22) attached to a tailgate (12) and a second end / tube (23) attached to the vehicle body (10); wherein when the counterbalance is in a fully extended position, the protective housing is oriented at an angle between the tailgate and the vehicle body (figure 1) and wherein the counterbalance is in the fully retracted position, the protective housing is oriented in a vertical position with respect to the vehicle body and the tailgate (please note that this is inherent from figure 1) . Kuspert lacks the specific counterbalance claimed.

Besonen et al provides a counterbalance capable of use on a tailgate of a motor vehicle, the counterbalance at least partially controls a load applied to the counterbalance comprising: an elastic element (30) that at least partially counters the load; a flexible extension limiter (25) that provides a stop which defines a fully extended

Art Unit: 3683

position of the counterbalance and which counters loads applied to the counterbalance after the counterbalance is in the fully extended position. Besonen lacks the specific teaching of using the counterbalance in conjunction with a tailgate.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the tailgate assembly of Kuspert with a counterbalance like that of Besonen to control the movement of the gate during opening and closing and to limit the extent to which the tailgate can be opened, thus protecting the hinges of the tailgate and increasing the life of the spring in the interior of the counterbalance due to fatigue.

In reference to claims 2 and 28, Besonen et al provides a counterbalance where the elastic element is a spring.

In reference to claims 5-6 and 29-30, Besonen et al provides a counterbalance where the flexible extension limiter is a material strap.

In reference to claims 7, 9 and 31-32, Besonen et al provides a counterbalance including a protective housing that at least partially covers the elastic member and the flexible extension limiter.

In reference to claims 13 and 33, Besonen et al provides the protective housing to include first and second tubes, the first tube having an opening that telescopically receives a portion of the second tube.

Allowable Subject Matter

3) Claims 41-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the references cited teach the configuration of the ribs claimed.

Response to Arguments

4) Applicant's arguments with respect to claims 1-2, 5-7, 9, 13 and 27-33 and 35-40 have been considered but are moot in view of the new ground(s) of rejection.

Please note that the examiner has switched the 103 rejection around in response to the amendment. Applicant argues that the combination would not have been obvious to one of ordinary skill in the art. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge of one of ordinary skill in the art would lead the combination of the references and further, both devices are found in the same classification class, thus they do not differ greatly in operation.

Conclusion

5) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 703-305-0839. The examiner can normally be reached on Mon-Fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3683

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DK

Robert A. Biconolfi 11/9/04
ROBERT A. BICONOLFI
PATENT EXAMINER